

REMARKS

Claims 8-11, 19-22, 24, and 26-41 are all the claims pending in the application.

Statement of Substance of Interview

Applicants' representative thanks the Examiner for the courtesies extended during the brief telephone interview conducted on March 10, 2008. During the interview, Applicants' representative pointed out that two different embodiments of Aoyama's disclosed method are being impermissibly combined, as discussed below in further detail with respect to the prior art rejection. The Examiner indicated that he understood the Applicants' position, and suggested the Applicants to file a formal response including the argument, so he can further discuss the case with his SPE and conduct a new search. Accordingly, this response includes the arguments submitted during the interview. As such, Applicants respectfully submit that this response places the application in immediate condition for allowance, subject to further search and/or consideration.

It is respectfully submitted that the instant STATEMENT OF SUBSTANCE OF INTERVIEW complies with the requirements of 37 C.F.R. §§1.2 and 1.133 and MPEP §713.04.

Allowable Subject Matter

Applicants thank the Examiner for indicating that claims 9, 11, 20, 22, 29, 31, 32, 36, 38, and 39 contain allowable subject matter and would be allowable if rewritten in independent form. Applicants request the Examiner to hold in abeyance such rewriting of these claims until the Examiner has an opportunity to reconsider and withdraw the prior art rejection of the other claims, in view of the aforementioned interview and the arguments submitted below with respect to the prior art rejection.

Claim Rejections - 35 U.S.C. § 102

Claims 8, 10, 19, 21, 24, 26-28, 30, 33-35, 37, 40, and 41 are rejected under 35 U.S.C. § 102(e) as allegedly being unpatentable over U.S. Patent No. 6, 865, 386 to Aoyama *et al* (“Aoyama”). For *at least* the following reasons, Applicants respectfully traverse the rejection.

Applicants respectfully submit claim 8 is patentable over Aoyama. For example, claim 8 recites that prior to the occurrence of said event said character is not related to said occurring event. In the previous Office Action dated February 14, 2007, the Examiner alleged that column 6, lines 27-33 of Aoyama discloses that prior to the occurrence of an event in Aoyama, the character is not related to said event. Here, Aoyama discloses that the telephone set automatically selects a character for display **at random**. The Examiner alleged that since the character is selected at random, there is no relation between the character and the event prior to the occurring event.

In the previous Amendment filed on November 9, 2007, in order to expedite prosecution, Applicants amended claim 8 to recite that the character presentation means selects said character from among the stored plurality of said characters depending upon the history information corresponding to said event. That is, the character selection means **does not** select the character that is to be displayed/animated **at random**. Rather the character selection means selects said character from among the stored plurality of said characters depending upon the history information corresponding to said event. Accordingly, Applicants submitted that claim 8 is not anticipated by Aoyama.

In the current Office Action, the Examiner asserts that col. 6, lines 27-33 also discloses this newly added feature of claim 8. Applicants respectfully disagree and submit that the Examiner is misapplying the teachings of Aoyama.

For instance, the Examiner is impermissibly using two different embodiments of Aoyama's disclosed method in an effort to render the claim unpatentable. Col. 6, lines 27-33, which relates to operation A3 in FIG. 2 of Aoyama (displaying a mail pickup scene for unread mail) is reproduced below:

“For the non-read information (for example, flag 0 for the non-read information), the control unit 4 displays the mail pickup scene by the character image previously set by the user in the initial setting (it is also possible that the hand-held telephone set automatically selects at random the character) as the still image consisting of single frame or as a moving image consisting of a plurality of frames (A3).”

That is, in the subject display operation, the control unit 4 either (1) displays the character that was previously set by the user (allegedly disclosing that the character presentation means selects said character from among the stored plurality of said characters depending upon the history information corresponding to said event) or (2) automatically select the character at random (allegedly disclosing that prior to the occurrence of said event said character is not related to said occurring event). When the control unit 4 implements one of the above two embodiments, the other embodiment is necessarily precluded from being implemented. In particular, if the character is selected at random in Aoyama, then the settings input by the user previously are not taken into account. On the other hand, if the character previously set by the user is displayed, then the character is, in fact, related to the occurring event and not selected at random. As such, Aoyama fails to disclose both the above-noted features of claim 1.

Moreover, Applicants submit that the two scenarios (1 and 2) relied on by the Examiner essentially represent two different operating conditions. Ex parte Beuther (71 USPQ2d 1313, 1316 (BPAI 2003)) dictates that these different operating conditions, such as from different embodiments cannot be combined absent a specific teaching. As pointed out above, executing the display operation based on the teachings of one embodiment in Aoyama would bar execution

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of the display operation based on the teachings of the other embodiment. Therefore, Aoyama cannot teach any combination of the two embodiments.

In view of the foregoing, Applicants respectfully submit that claim 8 is not anticipated by Aoyama. Accordingly, withdrawal of the 35 U.S.C. § 102(e) rejection is respectfully requested.

The remaining independent claims, namely claims 19, 24, 26, 33, 40, and 41 also recite, in some variation, the above-noted feature of claim 8. Therefore, claims 19, 24, 26, 33, 40, and 41 are patentable *at least* for reasons given above with respect to claim 8.

Claims 10, 21, 27, 28, 30, 34, 37, and 35 are patentable *at least* by virtue of their dependency.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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